REMARKS

Claim 31 has been added, which new claim rewrites the limitations present in original Claim 8 to clarify treatment of itching and inflammation is where such conditions are not symptoms of infectious, neoplastic or rheumatic disorder. The new claim merely makes clear that which was present already in the original claim, and adds no new matter.

In the Office Action, being the first action in this application to address the merits (i.e., patentability) of the claims presented, the Examiner raises the following rejections and objections:

Rejection I. Claims 8-10, and 25-28 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement with respect to "disorders which [are] non-infective, non-neoplastic, non-rheumatic disorders involving itching and or inflammation." [The Examiner explicitly states that the recitation "treating and/or prophylaxis of pruritis" in the claims is enabling.]

Applicant respectfully traverses this rejection, for reasons hereinafter presented in the subsequent and corresponding Section I of this response.

Rejection II. Claims 8-10 and 25-28 stand rejected under 35 U.S.C. Section 103(a) as unpatentable over the disclosure of U.S. Patent No. 6,248,763 ("Scivoletto"), in view of the disclosure in U.S. Patent No. 5,496,827 ("Patrick"). Although the Examiner references only Scivoletto and Patrick in the paragraph setting forth the rejection, the rationale supporting the finding of obviousness cites a further patent, U.S. Patent No. 5,976,844, issued to Kaesler, et al ("Kaesler").

Applicant respectfully traverses this rejection, for reasons hereinafter presented in the subsequent and corresponding Section II of this response.

Rejection III. Claims 9-10 stand objected to under 35 U.S.C. Section 112, second paragraph, as indefinite for allegedly combining a broad range or limitation with a narrower and encompassed stated range or limitation, as the Examiner considers "uremic pruritus" and "senile pruritus" as narrower that the pruritus as described in these claims.

With respect to the above referenced objection based on 35 U.S.C. Section 112, second paragraph, in the amendment above, Applicant has deleted both "uremic pruritus" and "senile puritus," respectively, from Claims 9 and 10. Applicant submits this addresses and resolves the objection raised as to indefiniteness of these claims.

In the Office Action, the Examiner also responds to Applicant's arguments supporting traversal of the requirements for restriction and election of species raised previously and in advance of examination on the merits. In this, the Examiner reiterates her contention that the three claim groupings identified share no unity of invention because they allegedly lack novelty (as purportedly evidenced by Patrick and by another U.S. Patent, No. 5,053,396 issued to Blass, et al ("Blass"). The Examiner also reiterated her rationale for election of species in that pruritus requires "therapeutically different treatment that other non-infective, non-neoplastic, non-rheumatic disorders involving itching and/or inflammation." This contention was unsupported by any evidence, however.

In response to the restriction requirement, Applicant, with traverse, elected claims 8-11 and 25-28. Thereafter, the Examiner required Applicant to elect a species from "pruritus" and a group of various disorders. In response thereto, applicant elected "pruritus."

The Examiner's stated rationale for these requirements has been, and continues to be, disputed by Applicant. As to restriction, the Examiner simply cannot rely on a conclusion reached in advance of any action on the merits that the subject claims lack novelty in view of one or more patents the Examiner characterizes as "demonstrate[ing] that the claimed feature does not define a contribution which each of the inventions, considered as a whole, makes over the prior art."

In reiterating its traversal, Applicant wishes to address certain glaring inconsistencies it perceives present in the examination of this application, which Applicant cannot let pass without comment.

The original grounds for the restriction requirement was an assertion by the Examiner that the Blass reference was novelty destroying. However, in this last paper, the first action on the merits, none of the rejections rely on Blass at all. This, at the very least, calls into question the propriety of the original restriction requirement. No citation or combination of citations advanced by the Examiner to support rejection disclose, teach or suggest combining nicotinimide or nicotinic acid and riboflavin, to the exclusion of any other anti-inflammatory or vitamin for the treatment of pruritus or other non-infective, non-neoplastic, non-rheumatic itching or inflammation disorder. Yet, each one of these elements absent in the citations is present and recited in each set of claims, as these have been grouped and subject to restriction.

Thus, the rejection actually illustrates what Applicant has noted all along: the restriction and election requirements lacked proper basis.

Applicant respectfully requests that the restriction and election requirements be withdrawn and that all claim groups and all claims therein be examined.

Addressing each remaining grounds for rejection raised in turn, Applicant submits the following arguments.

Rejection I. - Section 112 First Paragraph

Claims 8-10, and 25-28 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement with respect to "disorders which [are] non-infective, non-neoplastic, non-rheumatic disorders involving itching and or inflammation." Applicants respectfully traverse this rejection.

The Examiner previously required Applicants to elect a species of disorders. Subject to traverse, Applicants elected "pruritus." With respect to this election, the Examiner stated that "the elected claims...have been examined only to the extent that they read on use of the elected species in the claimed method." Later in the Office Action, the Examiner explicitly states the stated "treating and/or prophylaxis of pruritis" is enabling.

If by the Examiner's own admission the treatment or prophylaxis of the elected species is enabling, and no other species has been examined, it seems the rejection is improper on its face. Indeed, this rejection is directed solely to species that have apparently not been examined but, as Applicants contend, should have been examined. Curiously, it appears these have been examined, at least for enablement, found lacking, and rejected. Forcing the Applicants

to address only the enablement of these species, absent search, examination and consideration of other issues related to patentability is improper piecemeal examination. Consequently, if these species have been entirely examined, the election requirement is moot and should be reversed. Applicants respectfully request the Examiner clarify her position regarding examination of non-elected species.

Notwithstanding, and in respect to the rejection as advanced, Applicant has amended claim 8 and has provided new claim 31, each of which either 1) limits the application of the treatment to pruritus, i.e., the elected species; or 2) amends the claim for greater clarity to set forth the treatment as directed to itching and inflammation not symptomatic of infectious, neoplastic, or rheumatic origin. Hence, the disorders, whether puritus, itching or inflammation are clear and treatment of each as claimed is enabled, as demonstrated and supported by the specification, for instance, in the 5^{th} to 10^{th} clinical cases of the first series of clinical trials disclosed in the application, as well as elsewhere in the specification.

Therefore, given the amendment to the claims, and the ample disclosure of treatments for itching and inflammation as recited therein, Applicants submit the claims are enabled, notwithstanding that the rejection itself is directed to a non-elected species referenced not supposedly subject to examination.

Rejection II - Section 103(a)

Claims 8-10 and 25-28 stand rejected under 35 U.S.C. Section 103(a) as unpatentable over the disclosure of U.S. Patent No. 6,248,763 ("Scivoletto"), in view of the disclosure in U.S. Patent No. 5,496,827 ("Patrick"). Applicants respectfully traverse this rejection.

Although the Examiner references only Scivoletto and Patrick in the paragraph setting forth the rejection, the rationale supporting the finding of obviousness cites a further patent, U.S. Patent No. 5,976,844, issued to Kaesler, et al ("Kaesler"). Applicants therefore interpret the rejection as being over Scivoletto, in view of Patrick, and further in view of Kaesler.

Scivoletto discloses compositions for skin treatment including nicotinamide, nicotinic acid and nicotinic esters as active ingredients. (Abstract). Scivoletto does not disclose combinations of these nicotinic agents with riboflavin. Moreover, Scivoletto discloses combinations of nicotinic agents in compositions containing multiple other vitamin and antiinflammatory compositions. See for instance, Scivoletto, claims 1 and 2.

Patrick discloses a composition comprised of an effective concentration of methyl nicotinate in a diluent. (Abstract). Riboflavin is disclosed as one of various vitamins, minerals and/or nutrients to be included in the composition, but either only appears in compositions containing other vitamins such as thiamin, pyridoxine, panthenol, folic acid, cyanocobalamin, and others (See Example 1), or is disclosed as an agent to determine the transdermal delivery effectiveness of methyl nicotinate (illustrated by bright yellow urine color in a subject when topically administered in a diluent medium). (see for instance, Column 6, lines 5-10).

Kaesler discloses a process for microbial preparation of riboflavin by culturing riboflavin-producing microorganisms in a nutrient medium prior to isolation (Abstract). Kaesler further discloses, in the background section, riboflavin as essential for animals and humans, wherein riboflavin deficiency results in, among other conditions, itching and inflammation in skin folds. (Column 1, lines 9-14).

The Examiner references Scivoletto for teaching a pharmaceutical composition used in the treatment of itching from insect bits, bee stings, and fungi. The Examiner acknowledges, however, that Scivoletto fails to disclose combination of a nicotinic agent with riboflavin.

To fill this first acknowledged gap, the Examiner references Patrick for teaching a composition having an effective amount of nicotinic acid (e.g., methyl nicotinate) for treating dermatitis, acne or eczema, and which further discloses adding riboflavin to methyl nicotinate compositions. The Examiner acknowledges, however, that Patrick fails to teach that riboflavin is essential for itching or pruritus.

To fill this gap, the Examiner also references Kaesler for disclosing riboflavin as "essential" for itching and inflammation (although this is not how the disclosure reads in the relevant portion of Kaesler cited by the Examiner).

According to the Examiner, "it would have been obvious to treat itching (pruritus) with a combination composition of nicotinic acid (or its derivative such as methyl nicotinate) and riboflavin because the treatment can be advantageously benefitted by the said combination than a treatment with a single agent as suggested by these references, especially when it is taken together." The Examiner concluded riboflavin and nicotinic acid have been used individually for the treatment of itching, it would be obvious to combine these two compounds to yield a composition useful for the same purpose.

In order to establish a *prima facie* case of obviousness, each of the references cited must teach every element recited in the claims and identify the necessary motivation to combine these elements. *In re Rouffet,* 149 F. 3d 1350; 47 USPQ2d 1453 (Fed. Cir., 1998). The

cited references fail both to teach every element of Applicants claims and to identify the necessary motivation to combine the teaching to arrive at Applicants' claims. Statements with regard to expectations to somehow or other "maximize therapeutic efficiency" is merely hindsight analysis and do not suffice to "bridge over gaps in substantive presentation of an obviousness case." *Al-Site Corp. v. VSI International, Inc.*, 174 50 USPQ2d 1161 (Fed. Cir. 1999). It is respectfully submitted that the cited references fail not only to disclose or teach each element of the Applicant's claims, they also fail to provide the requisite suggestion *to do* what the applicants have done.

In support of the rejection, the Examiner has cited three patents, and alleges that features of each would be combined in one system and so arrive at the claims. The only possible support the Examiner provides for motivating this combination is merely noting that the citations may be from the same field of endeavor. This rationale, and the rejection as a whole, confer no specific and objective reason to combine the teachings of the references; without such the rejection is clearly insufficient, as a matter of law. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993).

Moreover, in none of these patents is a composition comprising riboflavin and nicotinic acid or nicotinamide as active ingredients disclosed as a therapeutic treatment for puritus, in any form, nor is it disclosed in a therapeutic composition of any type excluding other vitamins or anti-inflammatory agents. Indeed, such disclosure as is evident from the examples of compositions in Scivoletto and Patrick (Kaesler is directed to producing riboflavin, not to therapeutic compositions) name other vitamin compounds and anti-inflammatory agents. Clearly, the citations cannot account for all elements and limitations of the Applicants' claims.

For this reason alone, therefore, the rejection fails as a matter of law. *In re Rouffet,* 149 F. 3d 1350; 47 USPQ2d 1453 (Fed. Cir., 1998).

In addition, by disclosing such combinations of numerous active agents in preferred examples, the citations teach that addition of more vitamins and agents, not excluding these, maximize therapeutic effect. This clearly teaches away from the claims and their limitations. The Examiner's contention that combination lowers effective dosages and, thereby, ameliorates unwanted side effects argues for what Patrick and Scivoletto disclose, i.e., topical multi-vitamin treatments, not what is claimed which excludes multitudinous vitamin combinations. When considering the references also fail to disclose use of riboflavin and nicotinic acid in a compound for treating puritus or itching, it is clear the Examiner's purported motivation to combine is not founded on the references, and finds no support therein.

It is plain that the asserted combination is inadequate to make out a *prima facie* case of obviousness. The citations lack the disclosure to meet all of Applicants' claim elements and provide utterly no motivation for the asserted combination. The rejection is advanced based not on facts, but only on the Examiner's sometimes counter-intuitive speculation as to the ability of the asserted combination of three disparate citations to render Applicants' claims obvious. When a rejection under § 103 is not based on facts, it cannot stand. *Ex parte Porter,* 25 USPQ2d 1144, 1147 (BPAI 1992). Speculation and conjecture are not substitutes. Therefore, the rejection fails. All claims should be allowed.

CONCLUSION

For the reasons heretofore discussed, Applicant submits that the original restriction requirement and election of species demand were made in error and should be withdrawn. Examination should extend to all claims originally presented.

Moreover, the advanced rejections of the elected claims, for the species elected therein, are also demonstrably improper and should be withdrawn.

Favorable consideration and allowance of all claims originally presented, and as added or amended, is respectfully solicited.

Respectfully submitted,

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